

REMARKS

Claims 1-2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sampath. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Sampath does not disclose or suggest “an entity referring unit for searching the template database part *and the variable-content database part on the basis of the character train variable and the data variable with a tag*” (emphasis added) and apparently concludes that such a feature would have been obvious. It is respectfully submitted that the Examiner’s allegation is *per se* improper because the Examiner has not provided any prior art which discloses the claimed feature as required under § 103.

Indeed, according to one aspect of the present invention based on the claimed combination, a database component with a tag can be selected *based on an instruction of a relative path* for selecting a database component with a tag (*see, e.g.,* example on page 9, lines 4-12 of Applicants’ specification). In direct contrast, Sampath discloses only an element for *replacing a variable* with a value such as a database column name and looking for a corresponding database column, and an element for extracting a value based on the search result (*see* paragraph [0051]). Indeed, Sampath is completely unrelated to the aforementioned claimed feature, and provides absolutely no motivation whatsoever for the proposed modification.

The Examiner merely discounts the claimed features admittedly not disclosed in any of the applied references as allegedly being obvious without support whatsoever from any of the cited prior art. The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard for establishing obviousness under § 103:

To establish *prima facie* obviousness of a claimed invention, *all* the claim limitations must be taught or suggested *by the prior art*. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claim 1 because the cited prior art fails the "all the claim limitations" standard required under § 103. The Examiner has failed to identify any portions of the cited prior art which allegedly suggest the claimed structure. What the *Examiner* believes to be obvious is irrelevant in determining patentability under § 103.

In this regard, it is respectfully submitted that the Examiner has merely concluded that the claimed invention would have been obvious based on the Examiner's own *opinion*, which is not commensurate with the requirements under § 103. Accordingly, absent any prior art teachings of the specific features recited in the claims, the pending rejection is necessarily based solely on improper hindsight reasoning using only Applicants' specification as a guide to reconstruct the claimed invention. The "Examiner's opinion" can not be relied on to replace the deficiency of a prior art reference.

If the Examiner intended to take Official Notice that the differences between the present invention and cited prior art and/or the motivation to modify Sampath are well-known in the art, then pursuant to MPEP § 2144.03, Applicants respectfully traverse such an assertion and request the Examiner to cite a reference in support of his position (*see* second paragraph, last three lines of MPEP § 2144.03, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse). Indeed, only Applicants' specification discloses the claimed features and the motivation for providing it within the particular combination recited in claim 1.

At best, the Examiner's basis for the rejection amounts to nothing more than a general allegation that one of ordinary skill in the art *can* achieve the claimed invention, which is not a proper standard by which to make a rejection under § 103. The Examiner is directed to MPEP § 2143.03 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the proper standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that the cited prior art can be modified to reach the claimed invention, it is submitted that the "mere fact that [the cited prior art] can be modified ... does not render the resultant modification obvious" because nowhere does the *prior art* "suggest the desirability of the modification" as set forth by the Examiner.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

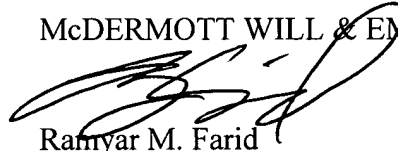
CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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